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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Isis E. Caulder Bereskin & Parr Box 407 40 King Street West Toronto, ON M5H 3Y2 CANADA		EXAMINER LIVERSEDGE, JENNIFER L		
		ART UNIT 3628 PAPER NUMBER		
DATE MAILED: 03/27/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/874,042

Applicant(s)

MARCH, ALBERT D.

Examiner

Jennifer Liversedge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/22/2001, 5/10/2002 and 8/17/2004
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities:

Page 12, line 2 should refer to Item 96 rather than 94.

Page 13, line 13 should read "diagrams which illustrate" or diagrams illustrating".

Page 15, lines 21 and 29 should refer to "Regional" rather than "Rogional" (may be poor copy).

Page 16, line 9 should refer to Item 170 rather than Item 164 per Figure 5.

Page 16, line 21 should read "addition" rather than "additional".

Page 19, lines 13, 15 and 19 should refer to Item 200 not Item 20.

Page 20, line 13 should read "equal" rather than "the equal".

Page 23, line 19 should read "wish" rather than "which".

Page 24, line 6 should read "sent" rather than "send".

Page 25, line 8 should refer to "cash" instead of "card".

Appropriate correction is required.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Item 218 on page 18, line 14.

The drawings are objected to because:

Item 16 should be "initiating" rather than "nitiating".

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Item 18 is missing the 1, it instead reads 8.

Items 202 and 204 are switched on the drawing according to the spec., page 19 lines 4-7.

Items such as data and signature should be assigned reference numbers and referenced in the spec.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 recites the limitation "said smart card" in line 21 of page 27. There is insufficient antecedent basis for this limitation in the claim. For purposes of

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examination, Examiner will assume that the smart card is intended to read as a financial card.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-9, 11, 14, 16-21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,650,604 to Marcous et al. (further referred to as Marcous), and further in view of U.S. Patent Number 6,105,009 to Cuervo (further referred to as Cuervo).

Regarding claim 1, Marcous discloses a financial transaction system for automated electronic transfer of funds (column 1, lines 7-12) comprising:

(a) a receiving center for receiving a transfer request from a sender for a predetermined amount of funds (column 1, lines 24-46; column 3, lines 40-65);

(b) a dispensing center linked to said receiving center for dispensing said predetermined amount of funds to the recipient (column 2, lines 24-47; column 4, lines 16-30).

Marcous does not disclose a financial card containing the predetermined amount of funds provided by the dispensing center to the recipient. However, Cuervo discloses a financial card containing the predetermined amount of funds provided by the dispensing center to the recipient (column 2, lines 5-21). It would be obvious to one of ordinary skill in the art to combine the dispensing of debit cards as disclosed by Cuervo with the EFT/ATM system dispensing cash and cash equivalents (column 2, lines 33-38) as disclosed by Marcous. The motivation would be to provide a variety of monetary mechanisms by which to transfer and receive funds in cash equivalent forms.

Regarding claim 2, Marcous discloses the financial transaction system further comprising an authorization center linked to said receiving center for authorizing the transfer (column 4, lines 11-25; column 8, lines 53-67; column 9, lines 1-57).

Regarding claim 3, Marcous discloses the financial transaction system wherein said authorization center is linked to said receiving center and said dispensing center over a communications network (column 3, lines 50-63; column 4, lines 42-64; column 5, lines 29-67, Figure 1).

Regarding claim 4, Marcous discloses the financial transaction system wherein said communications network is an automated teller machine (ATM) network (column 4, lines 42-64; column 10, lines 7-22).

Regarding claim 5, Marcous discloses the financial transaction system wherein the authorization center includes an account database for storing transactional information associated with the use of said financial card (column 7, lines 17-41; column 9, lines 1-11 and lines 40-67).

Regarding claim 6, Marcous discloses the financial transaction system wherein the sender is coupled to said receiving center through an ATM network (column 4, lines 30-64; column 10, lines 7-22).

Regarding claim 7, Marcous discloses the financial transaction system wherein the sender is coupled to said receiving center through a personal computer with a graphical user interface (column 3, lines 50-58; column 4, lines 42-64).

Regarding claim 8, Marcous discloses the financial transaction system wherein the sender is coupled to said receiving center through a touch-tone telephone with a voice response unit (column 3, lines 50-58; column 4, lines 42-64).

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Regarding claim 9, Marcous discloses the financial transaction system wherein said receiving center includes a financial card reader (column 3, lines 40-64; column 7, lines 49-55).

Regarding claim 14, Marcous discloses the financial transaction system wherein said receiving center further comprises a cash acceptance mechanism (column 3, lines 40-65).

Regarding claim 16, Marcous discloses a method for transferring funds (column 1, lines 7-12) comprising:

receiving from a sender a request to transfer a predetermined amount of funds (column 1, lines 24-46; column 3, lines 40-65);

Marcous does not disclose generating a financial card containing the predetermined amount of funds; and dispensing the financial card to a recipient. However, Cuervo discloses generating a financial card containing the predetermined amount of funds; and dispensing the financial card to a recipient (column 2, lines 5-21). It would be obvious to one of ordinary skill in the art to combine the generating and dispensing debit cards as disclosed by Cuervo with the EFT/ATM system dispensing cash and cash equivalents (column 2, lines 33-38) as disclosed by Marcous. The motivation would be to provide a variety of monetary mechanisms by which to transfer and receive funds in cash equivalent forms.

Regarding claim 17, Marcous discloses the method further comprising the step of receiving a sender verification ID protocol from the sender, receiving a sender verification ID protocol from the sender, receiving a recipient verification ID protocol, and confirming that the recipient verification ID protocol corresponds to the sender verification ID protocol before step (b) (column 4, lines 11-29; column 5, lines 17-28; column 7, lines 24-34; column 8, lines 53-67; column 9, lines 12-27).

Regarding claim 18, Marcous discloses the method further comprising the step of receiving financial information from said sender specifying the location of the amount of funds (column 1, lines 38-46; column 2, lines 48 – column 3, line 3; column 3, line 40- column 4, line 5; column 4, lines 11-30). (As the sender is sending the funds electronically and communicates the authorizations codes and fund amounts, the sender would instruct the receiver to go to any ATM with EFT capability of their choice to receive the funds, in other words, specific directions are not required as the ATMs operate on networks and any number of ATMs would be useful in the EFT process).

Regarding claim 19, Marcous discloses the method further comprising the step of allowing the recipient to provide a verification PIN number to secure (said financial card) (column 4, lines 11-30).

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Regarding claim 20, Marcous discloses the method further comprising the step of dispensing (said financial card) to the recipient through an ATM (column 2, lines 44-52; column 3, line 40 – column 4, line 30).

Regarding claims 11 and 21, Marcous does not disclose the financial transaction system wherein said financial card is a debit card. However, Cuervo discloses the financial transaction system wherein said financial card is a debit card (column 2, lines 5-21). It would be obvious to one of ordinary skill in the art to combine the dispensing of debit cards as disclosed by Cuervo with the EFT/ATM system dispensing cash and cash equivalents (column 2, lines 33-38) as disclosed by Marcous. The motivation would be to provide a variety of monetary mechanisms by which to transfer and receive funds in cash equivalent forms.

Regarding claim 24, Marcous discloses a financial transaction system for automated electronic transfer of funds (column 1, lines 7-12) comprising:

(a) means for receiving a transfer request from a sender for a predetermined amount of funds (column 1, lines 24-46; column 3, lines 40-65);

(b) means linked to said receiving center for dispensing said predetermined amount of funds to the recipient (column 2, lines 24-47; column 4, lines 16-30).

Marcous does not disclose a financial card containing the predetermined amount of funds provided by the dispensing center to the recipient. However, Cuervo discloses a financial card containing the predetermined amount of funds provided by the

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dispensing center to the recipient (column 2, lines 5-21). It would be obvious to one of ordinary skill in the art to combine the dispensing of debit cards as disclosed by Cuervo with the EFT/ATM system dispensing cash and cash equivalents (column 2, lines 33-38) as disclosed by Marcous. The motivation would be to provide a variety of monetary mechanisms by which to transfer and receive funds in cash equivalent forms.

Claims 10 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcous and Cuervo as applied to claims 1 and 16 above, and further in view of U.S. Patent No. 6,636,833 B1 to Flitcroft et al. (further referred to as Flitcroft). Neither Marcous nor Cuervo disclose the financial transaction system wherein said financial card is a credit card. However, Flitcroft discloses the financial transaction system wherein said financial card is a credit card (column 18, lines 18-24). It would be obvious to one of ordinary skill in the art to combine the dispensing of credit cards as disclosed by Flitcroft with the EFT/ATM system dispensing cash and cash equivalents (column 2, lines 33-38) as disclosed by Marcous and Cuervo. The motivation would be to provide a variety of monetary mechanisms by which to transfer and receive funds in cash equivalent forms.

Claims 12 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcous and Cuervo as applied to claims 1 and 16 above, and further in view of U.S. Patent No. 6,048,271 to Barcelou (further referred to as Barcelou). Neither Marcous nor Cuervo disclose the financial transaction system wherein said financial

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card is a smart card. However, Barcelou discloses the financial transaction system wherein said financial card is a smart card (column 7, lines 52-62). It would be obvious to one of ordinary skill in the art to combine the dispensing of smart cards as disclosed by Barcelou with the EFT/ATM system dispensing cash and cash equivalents (column 2, lines 33-38) as disclosed by Marcous and Cuervo. The motivation would be to provide a variety of monetary mechanisms by which to transfer and receive funds in cash equivalent forms.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marcous and Cuervo as applied to claim 1 above, and further in view of U.S. Patent No. 6,298,336 B1 to Davis et al. (further referred to as Davis). Neither Marcous nor Cuervo disclose the financial transaction system wherein said financial card is a stored value card. However, Davis discloses the financial transaction system wherein said financial card is a stored value card (column 5, lines 12-18). It would be obvious to one of ordinary skill in the art to combine the dispensing of smart cards as disclosed by Davis with the EFT/ATM system dispensing cash and cash equivalents (column 2, lines 33-38) as disclosed by Marcous and Cuervo. The motivation would be to provide a variety of monetary mechanisms by which to transfer and receive funds in cash equivalent forms.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marcous and Cuervo as applied to claim 1 above, and further in view of U.S. Patent No.

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5,861,841 to Gildea et al. (further referred to as Gildea). Neither Marcous nor Cuervo disclose the financial transaction system wherein said financial card contains a GPS receiver. However, Gildea discloses the financial transaction system wherein said financial card contains a GPS receiver (column 1, lines 10-28). It would be obvious to one of ordinary skill in the art to combine the inclusion of a GPS device in the financial card as disclosed by Gildea with the EFT/ATM system dispensing cash and cash equivalents (column 2, lines 33-38) as disclosed by Marcous and Cuervo. The motivation would be to enable the location of the financial card and it's user for currency exchange and tracking of one's safety purposes.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S. Patent No. 5,963,647 to Downing et al. in which a method and system for transferring funds through an ATM or CAT is disclosed in which cardless withdrawing of funds using code words and a PIN for authorization is disclosed.

U.S. Patent No. 6,006,988 to Behrmann et al. in which non-cash cards are processed and dispensed from ATMs.

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday – Friday, 8:30 – 5 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached at 571-272-6799. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge

Examiner

Art Unit 3628


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